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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/700,496 | 11/05/2003 | Ken Hirunuma | P24122 | 6278 |
| 7055 | 7590 | 10/18/2005 | EXAMINER | |
| GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191 | | | PRITCHETT, JOSHUA L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2872 | |
| DATE MAILED: 10/18/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/700,496

Applicant(s)

HIRUNUMA ET AL.

Examiner

Joshua L. Pritchett

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This action is in response to Amendment filed August 19, 2005. Claim 7 has been added as requested by the applicant.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 3-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Wu (US 2005/0018048).

Regarding claim 1, Wu discloses a digital camera provided binoculars comprising a digital camera (2) that is able to capture an image of an object which is observed through optical systems of the binoculars (para. 0019); an a microphone (para. 0022) wherein the microphone is provided one a bottom face of the binoculars (Fig. 1). Figure 1 shows the digital camera (2), which is also the microphone on a face of the binoculars. The Wu reference does not disclose whether this is the top or bottom face. The examiner interprets the Wu reference to allow the digital camera (2) to be located on either the top or the bottom face depending on the user's preference to actuate the buttons (22 and 23) with either an index finger or a thumb.

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Regarding claim 3, Wu discloses sound information collected by the microphone is recorded in association with an image captured by the digital camera (para. 0004).

Regarding claim 4, Wu discloses the recording using the microphone is carried out just after an image capturing operation of the digital camera (para. 0013, para. 0018-0023). Wu states the button (23) switches between the modes of the digital camera (2) (para. 0013). The modes are then listed (para. 0018-0023) meaning that after an image is captured the user must switch modes to record the sound, thus the sound is recorded just after the image is captured.

Regarding claim 5, Wu disclose the microphone is positioned on the bottom face and in the vicinity of a rear face where ocular lenses of the binoculars are provided (Fig. 1).

Regarding claim 6, Wu discloses the microphone is positioned on the bottom face and between a pair of optical systems of the binoculars (Fig. 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wu (US 2005/0018048) in view of Hirunuma (US 2003/0063189).

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Wu teaches the invention as claimed but lacks reference to a tripod. Hirunuma teaches the use of a tripod attached to the bottom face of a digital camera provided binocular assembly (para. 0072). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the Wu invention include the tripod as taught by Hirunuma for the purpose of capturing a clear image that is not impacted by hand vibrations.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wu (US 2005/0018048) in view of Nagumo (JP 08-098209).

Wu teaches the invention as claimed but lacks reference to the camera and microphone located on different surfaces. Nagumo teaches the camera (2a-b) and the microphone (5a-b) mounted on different surfaces of the binoculars (Fig. 1A). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Wu reference have the microphone and camera on different surfaces as taught by Nagumo for the purpose of allowing repair to one of the two systems without requiring any contact with the second system as well as limiting the heat created by the circuitry for each system to prevent any damage to either system caused by accumulated heat.

Response to Arguments

Applicant's arguments filed August 19, 2005 have been fully considered but they are not persuasive.

Applicant argues that the Wu reference fails to show the microphone located on the bottom face of the binoculars. Fig. 4 of Wu shows that the input module includes both the CCD sensor and the microphone, therefore the microphone would be within the structure labeled 2 in Fig. 1. The examiner holds that the Wu invention is capable of use with the camera (2) located on either the top or bottom surface. The applicant argues that it is not reasonable to assume that a user of the Wu invention would use the device upside down. The Wu reference does not include any ergonomic bend to the binoculars that would make it uncomfortable for a user to operate the binoculars in an inverted position to that shown in Fig. 1. Therefore it does not appear to be unreasonable to assume that one may choose to operate the binoculars based on a preference of use of a thumb instead of an index finger or dependent upon which hand of the user is dominant. Further, if the applicant's arguments were held to be persuasive any person who happened to accidentally pick up the Wu binoculars upside down would be infringing on the applicant's patent.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Boys (US 2002/0069070) teaches binoculars with a microphone where the microphone can be located in any convenient location.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua L. Pritchett whose telephone number is 571-272-2318. The examiner can normally be reached on Monday - Friday 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLP *P*


DREW A. DUNN
SUPERVISORY PATENT EXAMINER